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**OFFICE OF PETITIONS
A/C PATENTS**

In re Patent No. 5,985,309 :
Issue Date: November 16, 1999 :
Application No. 08/971,791 :
Filed: November 17, 1997 :
Attorney Docket No. MIT-7513/7804 :

ON PETITION

This is a decision on the petition under 37 CFR 1.183, filed October 27, 2000, to waive the rules and accept the correction of the assignee on the front page of the above-identified patent. The petition is also being treated as a petition under 37 CFR 1.181 requesting review of the denial of the Decisions & Certificates of Correction Branch's decision mailed July 19, 2000 refusing issuance of a certificate of correction without a grantable petition under 37 CFR 1.183.

The request to review the decision of the Decisions & Certificates of Correction Branch is granted to the extent that the decision has been reviewed but is dismissed with respect to making any changes therein.

The petition under 37 CFR 1.183 is granted.

Petitioner contends that the denial of the request for a certificate of correction to add "The Penn State Research Foundation" as an assignee on the front page of the Letters Patent is in error since petitioner's postcard receipt stamped by the USPTO indicated that both the Issue Fee Transmittal sheet and Part B - Issue Fee Transmittal Addendum, which sets forth the second assignee's name, were received.

A review of the file record indicates that the addendum to the Issue Fee Transmittal Form PTOL-85(b) was in fact received. However, in reviewing the Issue Fee Transmittal Form, it is noted that the form fails to draw any attention whatsoever to the fact that an addendum containing a second assignee's name is attached. Without such information being provided on the form, the printers will

not normally look for information contained in another paper filed therewith generally intended for another purpose, such as certificate of mailing information or itemization of papers being submitted. The Office prints the information to be printed on the patent solely from the Issue Fee Transmittal Form, unless otherwise specifically indicated thereon.

Note MPEP Section 307, which states that "[u]nless an assignee's name and address are identified in item 3 of the Issue Fee Transmittal form PTOL-85B, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied." MPEP Section 307 also states that a request for a certificate of correction arising from incomplete or erroneous assignee's name furnished in item 3 of PTOL-85B will not be granted unless a petition under 37 CFR 1.183 has been granted.

In the instant case, item 3 of PTOL-85B contains incomplete information, i.e., an indication to note the second assignee's name and address on the addendum accompanying the Issue Fee Transmittal Form or the inclusion thereon of the second assignee's name and address. Therefore, petitioner's failure to indicate on the Issue Fee Transmittal Form the existence of a second assignee on an addendum resulted in the omission of the assignee information now sought to be added by way of a certificate of correction on the front page of the Letters Patent. Therefore, the failure to print the second assignee's name on the Letters Patent cannot be considered an error on the part of the PTO. Therefore, petitioner's request for a certificate of correction without fee must be dismissed.

Telephone inquiries concerning this matter may be directed to Frances Hicks at (703) 305-8680. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

The file is being forwarded to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.



Frances Hicks

Petitions Examiner

Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy